

Remarks

Applicant has amended claims 1, 17, 22 and 25, cancelled claim 5 and added new claims 29-32. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. (See e.g., (claims 1, 17, 22 & 25) Pars. 18, 21-25, 43-46, 50 & 54-55; (claims 29-32) Pars. 58-59.) Entry of the amendment and favorable consideration thereof is earnestly requested.

As amended, claims 1, 17 and 22 require, among other limitations, a camera control unit having a detachable configurable component the camera control unit receiving said configuration information and configuring said detachable configurable component for processing the image data, wherein said detachable configurable component is completely removable from said camera control unit such that a different detachable configurable component may be installed in said camera control unit. As amended, claim 25 requires, among other steps, configuring a detachable configurable component in the camera control unit to process the image data, removing the detachable configurable component, inserting a different detachable configurable component, retrieving information from the storage device, and configuring a different detachable configurable component in the camera control unit to process the image data.

The Examiner has rejected claims 1 and 25 over U.S. Patent No. 6,638,212 (Oshima et al.) in view of U.S. Patent No. 4,816,909 (Kimura et al.). Applicant submits that neither of these references teaches, discloses or suggest a detachable configurable component is completely removable from said camera control unit as recited in all the pending claims. The Examiner has also rejected claim 17 as anticipated by U.S. Patent No. 6,184,922 (Saito et al.) and rejected claim 22 over Saito et al. in view of U.S. Patent No. 5,627,583 (Nakamura et al.).

The Examiner has submitted the Saito et al. discloses a "camera control unit including at least one replaceable hardware component (Figure 1, Items 9, 10, 97)." (Official Action 1/25/07, p. 2.) However, as amended, all claims require that the detachable component is the configurable portion of the camera control unit. Saito et al. teaches that the items pointed to by the Examiner are "a still image-specific expansion unit 9 and motion picture-specific expansion unit 10 selectively coupled to a digital video output terminal 8 of the CCU 6 through which the digital video signal is output so that the selected expansion unit can be uncoupled freely." (Col. 3, Ins. 56-60.) Additionally, Saito et al. teaches that "a still image & motion picture-specific expansion unit 97 can be selectively connected to the CCU 6." (Col. 4, Ins. 13-15.) The expansion units (9, 10, 97) pointed to by the Examiner are provided with slots for receiving a PC card for transferring the various digital image information to a PC card for transfer to a computer. (See, Col. 3, In. 60 – Col. 4, In. 25; FIG. 1.) Nowhere does Saito et al. teach, disclose or suggest that the expansion sets comprise a detachable configurable component.

The Examiner also points to Nakamura et al. for teaching retrieval of information and configuration of a CCU, however, Applicant notes that Nakamura et al. fails to teach that the signal processing circuit 16 is detachable, rather, it is an integral part of and coupled to various devices within the CCU. (See, FIGS. 2, 6 & 7; Col. 4, Ins. 4-31.)

With regard to claim 9, which the Examiner rejected over Oshima et al. in view of Kimura et al and Saito et al., the Examiner states "Official Notice is taken that the use of FPGA devices for image processing is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use an FPGA device in the replaceable hardware components of Oshima in view of Kimura to allow for easy upgrading of the replaceable hardware device via reconfiguring the FPGA if necessary." (Official Action 1/25/07, pp. 7-8.) Applicant respectfully disagrees.

Neither Oshima et al. nor Kimura et al. teach, disclose or suggest a configurable CCU or a replaceable component. The Examiner is pointing to Nakamura et al. as teaching a configurable CCU and to Saito et al. as teaching a replaceable component. However, Applicant respectfully submits that the replaceable components of Saito et al. are expansion units as discussed above. The expansion units of Saito et al. receive a digital output signal that has already been processed and/or modified. The replaceable components of Saito et al. are not video processing circuitry for the CCU, rather they receive digital output signals to be transferred to a PC card for further transfer to a computer.

It is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See, e.g.,* MPEP 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."); *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (fact that prior art "may be capable of being modified to run the way the apparatus is claimed, there must be some suggestion or motivation in the reference to do so."). In the present case, Applicant respectfully submits that there is no suggestion that configurable circuitry in Nakamura et al. could be removable due to the fact that Saito et al. teaches use of a number of removable devices designed to receive a digital output video signal. "There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself." *In re Oetiker*, 977 F.2d, 1443, 1447 (Fed. Cir. 1992). *See also In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (suggestion to combine must be found in the prior art, not the applicant's disclosure). Applicant notes that none of the video processing circuitry is detachable in any of the cited references and the detachable circuitry pointed to by the Examiner

merely receives a processed digital output signal. The signal processing in Saito et al. happens before the digital output signal in input to the expansion units (9, 10, 97).

It is also well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ2d 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that the digital output connection coupling the expansion units (9, 10, 97) of Saito et al. to the CCU 6 cannot transmit all the necessary interconnections, signals, command or control requirements for the signal processing circuit (LCA) taught in Nakamura et al. (See, FIGS. 1, 6 & 7; Col. 4, Ins. 5-42.) Accordingly, even if one were to combine all of these references, one would have to substantially redesign the combination to arrive at the pending claims and it is not certain if the redesign would even function. However, there is certainly no suggestion to make the redesign of the combination from the references themselves. See e.g. *W.L. Gore and Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13, (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (It is impermissible to assemble the prior art using the pending claims as a roadmap to select various features from the prior art where there is no motivation in the references themselves for doing so.)

Accordingly, Applicant respectfully submits that because none of the cited prior art teaches, discloses or suggests a “camera control unit having a detachable configurable component” the “camera control unit receiving said configuration information and configuring said detachable configurable component for processing the image data, wherein said detachable configurable component is completely removable from said camera control unit such that a different detachable configurable component may be installed in said camera control unit” as recited by all pending claims, no combination thereof can render the pending claims obvious. Additionally, Applicant respectfully submits that there is no suggestion in any of the cited art to further modify the resulting

combination to arrive at the invention according to the pending claims and it is uncertain whether such a modification could even be made.

It is respectfully submitted that claims 1-4 and 6-32, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

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/Wesley W. Whitmyer, Jr./
Wesley W. Whitmyer, Jr., Registration No. 33,558
Steven B. Simonis, Registration No. 54,449
Attorneys for Applicants
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
Tel. 203 324-6155